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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,129	04/04/2005	Eric Verschueren	234855	9919

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LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6731

EXAMINER
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GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/530,129

Applicant(s)

VERSCHUEREN, ERIC

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/4/2005.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Response to Preliminary Amendment***

2. The preliminary amendment April 4, 2005 filed has been entered and fully considered.
3. Claims 1-40 are present.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-40 of copending Application No. 10/530,130 (US 2005/0287477 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because VERSCHUEREN claims a method of making a heat-sensitive lithographic printing plate precursor comprising the steps of providing a web of a lithographic support having a hydrophilic surface, applying a coating comprising a phenolic resin on the hydrophilic surface of the web, drying the coating, a heating step wherein the web temperature is maintained above 150 °C during a period of between 0.1 and 60 seconds, a cooling step wherein the web is reduced at an average cooling rate which is higher than if the precursor would be kept under ambient conditions and winding the precursor on a core or cutting the precursor into sheets.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have been allowed but not issued as a patented.

6. Claims 1-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-40 of copending Application No. 10/530,394 (US 2006/0000377 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed method of making a heat-sensitive lithographic printing plate precursor is obvious in view of the claims of VERSCHUEREN. Specifically VERSCHUEREN claims a method of making a heat-sensitive lithographic printing plate precursor wherein a web of a lithographic support is coated with a phenolic resin

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composition, the coating is dried, the web is heated in a heating step wherein the web temperature is maintained above 150°C during a period of between 0.1 and 60 seconds and a subsequently the web is cooled wherein the average cooling rate is at least 0.5°C/s.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-40 are rejected under 35 U.S.C. 102(e) as being anticipated by ABURANO et al. (US 6,723,489 B2).

a. ABURANO et al. teach a heat treatment of lithographic printing form precursors in web form comprising positive working polymeric coating on substrates. This heat treatment involves a relatively short heating stage followed by accelerated cooling (abstract). The precursor is preferably cooled to a temperature of 30°C or less in less than 1 hour (col. 4, lines 7-30). It is preferred that the precursor or precursors be

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subjected to a temperature not in excess of 110°C, most preferably not in excess of 80°C and in general not in excess of the glass transition temperature of the polymeric coating (col. 5, lines 9-46). In favorable situations, the precursor in web form is heat treated for not more than 8 hours and flash heating over a period of less than 2 minutes are taught (col. 5, lines 21-61). In Example 1, precursors comprising novolak resins were heating for 21 second to temperatures varying between 90 and 110°C and were cooled to a temperature of 30°C or less in 10 minutes. In Examples 2, the precursors were heated to a temperature of 150°C for 68, 38 and 21 seconds and cooled to a temperature of 30°C or less in 10 minutes.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over HUANG et al. (EP 1 074 386 A2).

a. The positive working polymeric resin coatings of HUANG et al. are coated onto a substrate such as in a printing plate and the coated element is given a heat treatment comprising a controlled slow cooling from an elevated temperature (abstract). According to Huang et al., controlled slow cooling means cooling under conditions such that heat is lost from the precursor more slowly than if it is cooled from the elevated

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temperature under ambient conditions ([0018]). When the composition comprises a phenolic resin, the elevated temperature is 90°C or above, preferably 110°C or above but is not so high as to cause irreversible modification of the composition, preferably does not exceed 150°C (preferably does not exceed 125°C) ([0022]). The glass transition temperature, T<sub>g</sub>, of compositions containing novolak resins is about 90-110°C ([0029]; [0031]. The cooling period is at least one hour, most preferably at least 6 hours and suitably the cooking rate is not greater than 1°C/min, most preferably not great than 0.2°C/min ([0033]-[0034]). HUANG et al. also teach an intermittent drying step ([0041]). Huang et al. specifically teach that an extended hold period is not needed when the precursors are heated to an elevated temperature exceeding the T<sub>g</sub> of the composition ([0022]), however HUANG et al. do not specifically the required period 0.1 to 60 seconds. Therefore it would have been obvious to one of ordinary skill in the art, through routine experimentation, to hold the precursors at an elevated temperature, exceeding the composition T<sub>g</sub>, for a time period sufficient to obtain precursors with high developer resistance in the unexposed areas ([0015]).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. In EP 1 172 697 A2, KAMITANI teach a method for manufacturing a lithographic printing plate wherein the printing plate support coated with a photosensitive layer comprising a phenolic resin is dried, heated to a maximum

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temperature of 125 to 145°C and cooled using a forced air cooling device (claims & [0037]-[0039], [0041]-[0068]).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Barbara L. Gilliam

Primary Examiner

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February 5, 2007